APPEAL BRIEF UNDER 37 C.F.R. § 41.37

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Jacek A. Grabiec   Examiner: Omkar A. Deodhar

Serial No.: 10/765,024   Group Art Unit: 3714

Filed: January 26, 2004   Docket: 1842.010US1

For: GAMING DEVICE AUDIO STATUS INDICATOR

APPEAL BRIEF UNDER 37 CFR § 41.37

Mail Stop Appeal Brief- Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

  The Appeal Brief is presented in support of the Notice of Appeal to the Board of Patent
Appeals and Interferences, filed on February 2, 2009, from the Final Rejection of claims 1-35 of
the above-identified application, as set forth in the Final Office Action mailed on November 28,
2008.

  The Commissioner of Patents and Trademarks is hereby authorized to charge Deposit
Account No. 19-0743 in the amount of $540.00 which represents the requisite fee set forth in 37
C.F.R. § 41.20(b)(2). The Appellants respectfully request consideration and reversal of the
Examiner's rejections of pending claims.

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1. REAL PARTY IN INTEREST

The real party in interest of the above-captioned patent application is the assignee, WMS GAMING INC..

2. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellant that will have a bearing on the Board's decision in the present appeal.

3. STATUS OF THE CLAIMS

The present application was filed on January 26, 2004 with claims 1-32. Claims 33-35 were added in prosecution, and claims 1, 2, 7, 8, 12, 14, 16, 17, 20-23, 27, 31, and 33 were amended in prosecution. Independent claims 1, 12, 23, 27, and 33 stand twice rejected, remain pending, and are the subject of the present Appeal.

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4. STATUS OF AMENDMENTS

No amendments have been made subsequent to the Final Office Action dated November 28, 2008.

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5. SUMMARY OF CLAIMED SUBJECT MATTER

Various embodiments of the invention as claimed include wagering game machine providing in a game mode a wagering game upon which monetary value can be wagered, and an audio module operable to report information comprising game technical information to a game administrator by a voice played via the audio module while in a service or configuration mode. The audio module is made operable to report game technical information by a game administrator causing the computerized gaming system to leave the game mode and enter the service or configuration mode.

INDEPENDENT CLAIM 1

1.   A computerized gaming system, comprising:

a gaming module, comprising a processor and gaming code which is operable when executed on the processor to conduct a game of chance on which monetary value can be wagered in a game mode; and

an audio module, the audio module operable to report information comprising game technical information to a game administrator by a voice played via the audio module while in a service or configuration mode, wherein the audio module is made operable to report game technical information by a game administrator causing the computerized gaming system to leave the game mode and enter the service or configuration mode.

INDEPENDENT CLAIM 12

12.   A method of providing game administrator interface with a computerized gaming system, comprising:

reporting game technical information of the computerized gaming system to a game administrator via a voice played by an audio system speaker when in a service or configuration mode, wherein the game administrator causes the computerized gaming system to enter the service or configuration mode, the computerized gaming system operable to execute gaming

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code on a processor to conduct a game of chance on which monetary value can be wagered when in a game mode.

INDEPENDENT CLAIM 23

23.   A computerized gaming system, comprising:

a gaming module, comprising a processor and gaming code which is operable when executed on the processor to conduct a game of chance on which monetary value can be wagered in a game mode;

a configuration module, operable to facilitate at least one of gaming system configuration or troubleshooting in a service or configuration mode; and

an audio module, the audio module operable to provide an audio voice interface to the configuration module wherein the audio module is made operable to report game technical information by a game administrator causing the computerized system to leave the game mode and enter the service or configuration mode.

INDEPENDENT CLAIM 27

27.   A method of managing a computerized gaming system, comprising:

reporting game configuration module information to a game administrator through voice via a speaker comprising part of an audio module operatively coupled to a game configuration module, wherein the game administrator causes the computerized gaming system to enter the configuration mode, the game configuration module operable to facilitate at least one of configuration or troubleshooting the computerized gaming system, wherein the audio module is made active to report game technical information by entering a service or configuration mode, the computerized gaming system operable to execute gaming code on a processor to conduct a game of chance on which monetary value can be wagered when in a game mode.

INDEPENDENT CLAIM 33

33.   A method of providing a game administrator interface with a computerized gaming system, comprising:

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operating the computerized gaming system in a game mode in which gaming code is executed on a processor to conduct a game of chance on which a user can wager monetary value;

leaving game mode;

entering a configuration or service mode based on an action of a game administrator; and

reporting game technical information of the computerized gaming system to the game administrator via a voice played by an audio system speaker.

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6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-23, 25-30, and 32-35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wolf et al. (U.S. Publication No. 2004/0072611; hereinafter "Wolf") in view of Shibazaki et al. (U.S. Patent No. 4,459,673; hereinafter "Shibazaki").

7. ARGUMENT

A) The Applicable Law under 35 U.S.C. §103(a)

The reference or references when combined must teach or suggest all the claim elements.
M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)). "The
identical invention must be shown in as complete detail as is contained in the ... claim."
Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989);
MPEP § 2131. "Anticipation requires the presence ... of each and every element of the claimed
invention, *arranged as in the claim.*" *Lindemann Maschinenfabrik GmbH v. American Hoist &
Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears,
Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

As discussed in *KSR International Co. v. Teleflex Inc. et al*. (U.S. 2007), the
determination of obviousness under 35 U.S.C. § 103 is a legal conclusion based on factual
evidence. *See Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 7, 1336-37 (Fed. Cir.
2005). The legal conclusion, that a claim is obvious within § 103(a), depends on at least four
underlying factual issues as set forth in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1,
17 (1966): (1) the scope and content of the prior art; (2) differences between the prior art and the
claims at issue; (3) the level of ordinary skill in the pertinent art; and (4) evaluation of any
relevant secondary considerations. The court in KSR further noted that "to facilitate review, this
analysis [supporting a rejection under 35 U.S.C. § 103(a)] should be made explicit." *Id.*

A Patent Examiner or a court must provide specific, objective evidence of record for a
finding of a suggestion or motivation to combine reference teachings and must explain the
reasoning by which the evidence is deemed to support such a finding. *See KSR Int'l Co.*, p. 14,
citing *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006); *In re Sang Su Lee*, 277 F.3d 1338, 61
USPQ2d 1430 (Fed. Cir. 2002).

In addition, the test for obviousness under §103 must take into consideration the
invention as a whole; that is, one must consider the particular problem solved by the combination
of elements that define the invention. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143,
227 USPQ 543, 551 (Fed. Cir.1985). The Examiner must, as one of the inquiries pertinent to any

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obviousness inquiry under 35 U.S.C. §103, recognize and consider not only the similarities but also the critical differences between the claimed invention and the prior art. *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990), *reh'g denied*, 1990 U.S. App. LEXIS 19971 (Fed. Cir.1990). The fact that a reference teaches away from a claimed invention is highly probative that the reference would not have rendered the claimed invention obvious to one of ordinary skill in the art. *Stranco Inc. v. Atlantes Chemical Systems, Inc.*, 15 USPQ2d 1704, 1713 (Tex. 1990). When the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious. *Id.* p. 4 citing *United States v. Adams*, 383 U.S. 39, 51-51 (1966). Additionally, critical differences in the prior art <u>must</u> be recognized when attempting to combine references. *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990), *reh'g denied*, 1990 U.S. App. LEXIS 19971 (Fed. Cir.1990).

Finally, the Court in *KSR* reaffirmed that "[a] factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of argument reliant upon ex post reasoning." *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d at 1397. *See also Graham v. John Deere Co.,* 383 U.S. at 36, 148 USPQ at 474.

B) Discussion of the rejection of claims 1, 12, 23, 27, and 33 under 35 U.S.C. § 103(a) as being unpatentable over Wolf et al. (U.S. Pub. No. 2004/0072611) in view of Shibazaki et al. (U.S. 4,459,673).

Rejection of these claims is respectfully traversed, and Appellant respectfully submits that the Final Office Action has made an improper prima facie showing of anticipation at least because the references fail to teach the claimed separate user mode and configuration or service mode, and fail to teach an administrator placing the machine in a service or configuration mode to make the audio module operable to report technical information.

Wolf describes a gaming system having a dynamic menu system operable to perform various functions, including setup, configuration, and diagnostic functions as illustrated in Figures 22-26.

Shibazaki describes a photocopier which is operable to provide a voice indication of a malfunction to a user upon some action by the user, such as by the user's attempting to operate the copier. Shibazaki does not have different service or configuration modes that are distinct from a user mode or other mode of normal operation, but uses the voice prompts as a user-friendly method of enabling a relatively unsophisticated user to resolve minor problems such as clearing a paper jam.

The Final Office Action argues that Shibazaki teaches a service mode, but fails to show that any particular part or feature of Shibazaki is a service mode or is anything other than a user mode voice prompt. Instead, the Office Action generally argued that a user who is notified of a paper jam through the audio functions but feels incapable of fixing the problem himself will notify an "administrator" (i.e. rather than another user) such that the administrator will clear the paper jam for the user. Applicant notes that clearing a paper jam is typically a user function in a copy machine, and is taught as such in Shibazaki, and has nothing to do with bringing a machine into a service or configuration mode.

Further, using a voice prompt to the user such that the user can notify an administrator to clear a paper jam is the opposite of entering a service or configuration mode to enable voice prompts. In the paper jam example, voice is used to summon a person who is an administrator, while in the pending claims the service or configuration mode enables voice prompts to the administrator.

Note also that Shibiazaki itself fails to actually discuss a system administrator or service personnel, but addresses only instructing users of the copy machine. Also, it is not alleged in the Office Action or taught in Shibazaki that the machine leaves a user mode and enters a service mode at any point, even should a service person (not taught in Shibazaki) for some reason assist in responding to Shibazaki's audible user voice indications.

The pending claims as amended in prosecution, in contrast, clearly recite a wagering game system having a normal user mode in which a user can play a wagering game, and a separate configuration or service mode accessible to a game administrator. The audio module is operable to report game technical information to a game administrator when the game administrator has brought the wagering game machine into the configuration or service mode, but does not report the game technical information to a user while in normal game mode.

Although Wolf includes a service mode, it does not describe a service mode in which game technical information is reported to a game administrator through a voice. Shibazaki also fails to teach reporting game technical information to an administrator when in a service mode, and further fails to teach a separate user mode and service mode, but teaches only that voice indications are provided to a user regarding operator tasks such as clearing paper jams. Neither reference therefore teaches reporting information comprising game technical information to a game administrator by a voice played via an audio module while in a service or configuration mode.

Significantly, neither reference teaches the claimed element of an audio module made operable to report game technical information by a game administrator causing the computerized gaming system to leave the game mode and enter the service or configuration mode, and the Final Office Action does not allege that such a feature is present in the prior art.

Because Shibazaki does not teach a separate user mode and configuration or service mode, and because it does not teach an administrator placing the machine in a service or configuration mode to make the audio module operable to report technical information, the pending claims are patentably distinct from the prior art. Reversal of the rejection of these pending claims is therefore respectfully requested.

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SUMMARY

For the reasons presented above, claims 1, 12, 23, 27, ands 33 were not properly rejected under § 102(3) as being unpatentable over Wolf in view of Shibazaki.

It is respectfully submitted that the art cited does not render the claims obvious and that the claims are patentable over the cited art. Reversal of the rejection and allowance of the pending claim are respectfully requested.

Respectfully submitted,

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Date _Ma 7 09_   By _____
                     John M. Dahl
                     Reg. No. 44,639

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this __7__ day of May 2009.

Zhakribzky M. Carnon _____
Name

Bhakribzky Carnon _____
Signature

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8. CLAIMS APPENDIX

1.   A computerized gaming system, comprising:

a gaming module, comprising a processor and gaming code which is operable when executed on the processor to conduct a game of chance on which monetary value can be wagered in a game mode; and

an audio module, the audio module operable to report information comprising game technical information to a game administrator by a voice played via the audio module while in a service or configuration mode, wherein the audio module is made operable to report game technical information by a game administrator causing the computerized gaming system to leave the game mode and enter the service or configuration mode .

2.   The computerized gaming system of claim 1, wherein the computerized gaming system further comprises a mechanical user interface.

3.   The computerized gaming system of claim 2, wherein the mechanical user interface is a mechanical reel slot machine interface.

4.   The computerized gaming system of claim 1, wherein game technical information comprises at least one of a game administrator menu, a game administrator help menu, a game troubleshooting menu, a game test menu, and a game setup menu.

5.   The computerized gaming system of claim 1, the audio module further operable to report error condition information.

6.   The computerized gaming system of claim 5, wherein the audio module is operable to report error condition information upon actuation by a game administrator.

7.   The computerized gaming system of claim 1, further comprising a monitoring module, the monitoring module operable to monitor the state of one or more components of the computerized gaming system, the audio module further operable to report monitoring module data to a the game administrator.

8.   The computerized gaming system of claim 1, wherein the audio module is further operable to convey information regarding an executing game of chance to a user.

9.   The computerized gaming system of claim 1, the audio module operable to report information comprising game technical information to a game administrator when the game of chance is not executing.

10.   The computerized gaming system of claim 1, the audio module further operable to prompt a game administrator to perform test or configuration functions.

11.   The computerized gaming system of claim 1, the audio module operable to report information in one or more languages.

12.   A method of providing game administrator interface with a computerized gaming system, comprising:
       reporting game technical information of the computerized gaming system to a game administrator via a voice played by an audio system speaker when in a service or configuration mode, wherein the game administrator causes the computerized gaming system to enter the service or configuration mode, the computerized gaming system operable to execute gaming code on a processor to conduct a game of chance on which monetary value can be wagered when in a game mode.

13.   The method of claim 12, wherein the computerized gaming system comprises a mechanical user interface.

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14.   The method of claim 13, wherein the mechanical user interface is a mechanical reel slot machine interface.

15.   The method of claim 12, wherein game technical information comprises at least one of a game administrator menu, a game administrator help menu, a game troubleshooting menu, a game test menu, and a game setup menu.

16.   The method of claim 12, wherein game technical information comprises error condition information.

17.   The method of claim 12, wherein the game technical information is reported upon actuation by the game administrator.

18.   The method of claim 12, further comprising monitoring the state of one or more components of the computerized gaming system, and reporting the monitored state as game technical information to the game administrator via the audio system.

19.   The method of claim 12, further comprising conveying information regarding an executing game of chance to a user via the audio system.

20.   The method of claim 12, the audio system operable to report information comprising game technical information to the game administrator when the game of chance is not executing.

21.   The method of claim 12, further comprising prompting the game administrator via the audio system to perform test or configuration functions.

22.   The method of claim 12, the audio system operable to convey information to the game administrator in one or more languages.

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23. A computerized gaming system, comprising:

a gaming module, comprising a processor and gaming code which is operable when executed on the processor to conduct a game of chance on which monetary value can be wagered in a game mode;

a configuration module, operable to facilitate at least one of gaming system configuration or troubleshooting in a service or configuration mode; and

an audio module, the audio module operable to provide an audio voice interface to the configuration module wherein the audio module is made operable to report game technical information by a game administrator causing the computerized system to leave the game mode and enter the service or configuration mode.

24. The computerized gaming system of claim 23, wherein the audio voice interface comprises a hierarchal menu conveyed by voice.

25. The computerized gaming system of claim 23, wherein the computerized gaming system comprises a game having a mechanical interface operable to convey results of the game of chance.

26. The computerized gaming system of claim 23, the audio module further operable to convey audio to a player of the game of chance.

27. A method of managing a computerized gaming system, comprising:

reporting game configuration module information to a game administrator through voice via a speaker comprising part of an audio module operatively coupled to a game configuration module, wherein the game administrator causes the computerized gaming system to enter the configuration mode, the game configuration module operable to facilitate at least one of configuration or troubleshooting the computerized gaming system, wherein the audio module is made active to report game technical information by entering a service or configuration mode, the computerized gaming system operable to execute gaming code on a processor to conduct a game of chance on which monetary value can be wagered when in a game mode.

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28.   The method of claim 27, further comprising:

receiving game configuration module input from a game administrator in response to audio conveyed via the audio module.

29.   The method of claim 28, wherein the game configuration module input is received via actuating controls configured to provide input for the game of chance.

30.   The method of claim 28, wherein the game configuration module input is received via actuating one or more switches.

31.   The method of claim 27, wherein reporting game configuration module information to a game administrator through voice via an audio module comprises conveying a hierarchal menu by voice.

32.   The method of claim 27, wherein reporting game configuration module information to a game administrator through voice via an audio module comprises conveying such information in a selected language.

33.   A method of providing a game administrator interface with a computerized gaming system, comprising:

operating the computerized gaming system in a game mode in which gaming code is executed on a processor to conduct a game of chance on which a user can wager monetary value;

leaving game mode;

entering a configuration or service mode based on an action of a game administrator; and

reporting game technical information of the computerized gaming system to the game administrator via a voice played by an audio system speaker.

34.   The method of providing a game administrator interface with a computerized gaming system of claim 33, further comprising:

detecting a malfunction in the computerized wagering game system.

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35.   The method of providing a game administrator interface with a computerized gaming system of claim 34, wherein detecting the malfunction causes the computerized wagering game system to leave game mode.

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9. EVIDENCE APPENDIX

None.

10. RELATED PROCEEDINGS APPENDIX

None.